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| 10/070,623      | 03/04/2002  | Stephen Wayne Arbuckle | BC2449USA           | 9172             |

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PATENT DOCKET DEPARTMENT  
GARDNER CARTON & DOUGLAS LLC  
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CHICAGO, IL 60606

EXAMINER

LOVERING, RICHARD D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1712

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,623

Applicant(s)

ARBUCKLE ET AL

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on JUNE 27 & AUG. 19, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-64 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 8-43, 54-56 AND 62-64 is/are allowed.
- ☒ Claim(s) 1, 5, 44-48, 50, 51, 57 AND 58 is/are rejected.
- ☒ Claim(s) 2-4, 6, 7, 49, 52, 53 AND 59-61 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 344 ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 5 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Bender et al. 2,858,342, esp. Examples I and II.

4. Claims 44-46, 51, 57 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 60261639A DaiNippon Inc. Chem. KK, hereinafter "DaiNippon", esp. Abstract. In their Example DaiNippon charge a mixture of phenol, bisphenol and formalin to a flask, add KOH as a catalyst, and raise the

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temperature to 80°C, reaction taking place to reach water tolerance of 500%, after which the mixture is cooled, neutralized to 6.5-7.0 pH and submitted to distillation to obtain bisphenol F modified phenol formaldehyde resin precondensate. It would have been obvious to one skilled in the art at the time applicant's invention was made to add the bisphenol after water tolerance of 500% is reached in DaiNippon instead of including it in the original reactants because selection of any order of mixing of ingredients is prima facie obvious in the absence of new or unexpected results. In this connection, see In re Burhans, 154 F. 2d 690, 69 USPQ 330 (CCPA 1946); and In re Gibson, 39 F. 2d 975, 5 USPQ 230 (CCPA 1930).

5. Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over DaiNippon as applied to claims 44-46, 51, 57 and 58 above, and further in view of Kreibich et al. Re. 26,881. DaiNippon applies as set forth in the preceding paragraph. It would have been obvious to one skilled in the art at the time applicant's invention was made to substitute the NaOH of Kreibich et al. (Example 1) for KOH in DaiNippon or to use calcium acetate of Kreibich et al. (Example 1) in the above modification of DaiNippon because Kreibich et al. disclose the use of the stated compounds in making similar phenol-formaldehyde resins and because DaiNippon, second sentence below the title in

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the Abstract, contemplate any alkali metal and/or alkaline earth metal compound as catalyst.

6. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over DaiNippon as applied to claims 44-46, 51, 57 and 58 above, and further in view of Fry 4,124,554. DaiNippon applies as set forth in paragraph 4 above. It would have been obvious to one skilled in the art at the time applicant's invention was made to use bisphenol A instead of bisphenol F in the above modification of DaiNippon because Fry (Example 1) exemplifies the use of bisphenol A in making similar phenol-formaldehyde resins and because the use of one old, well-known bisphenol known to be useful in making phenol-formaldehyde resins for another is within the expected skill of a worker in the art.

7. Claims 2-4, 6, 7, 49, 52, 53 and 59-61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the bisphenolic compositions of claims 2-4, 6, 7 and 23-27; the methods of making them of claims 8-22; the resins of claims 28-43 and 59-61; the methods of making them of claims 49 and 52-56; and the resin impregnated products of claims 62-64.

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9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

10. The remaining references listed on the attached Form PTO-1449 (three sheets) and Form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc  
May 14, 2003

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP ~~1200~~ 1700